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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,646	07/27/2000	David H. Tannenbaum	T0615-P005US-08008819	9955

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EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,646

Applicant(s)

TANNENBAUM, DAVID H.

Examiner

Krisna Lim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 27-43, 52-60, 79 and 80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 44-51, 61-70 and 75-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's election with traverse of the invention Group I claims 1-26, 44-51, 61-70 and 75-78 in Paper No. 8 (filed 10/29/03) is acknowledged. The traversal is on the ground(s) as following:

a) On page 2 of the applicant remark, the applicants' arguments: i) Group I has three elements (recording, accessing and determining) while Group III has four elements (input and store, accessing, determining and delivering) however those elements are essentially the same. For example, inputting and storing of desired program are essentially the same as recording information because the programs are a subset of information). **In reply**, Examiner submits that the applicant has a good point of argument; however, Examiner respectfully disagrees because the scope of the claimed language has its own interpretation. For example, it is not necessarily that recording step is essentially must have the step of inputting and storing. Moreover, it is not necessarily that the programs are a subset of information because information may not be the programs (desired programs input and stored by the user). Moreover, Group I specifically calls for a method for delivering **information** to a requesting user while Group III specifically calls for a system for delivering **entertainment programs** to a user. The scope of the requesting information by a user is different from the scope of delivering entertainment program to a user.

b) On page 3 of the applicant remark, the applicant arguments:

i) the step of accepting the information (of claim 27) is certainly similar to the step of accessing and recording the information (of claim 1).

ii) the step of matching (of claim 27) is a similar concept to the step of determining of claim 1. **In reply**, Examiner submits that the applicant has a point of argument; however, Examiner respectfully disagrees because first of all Group I calls for three steps (recording, accessing and determining) while Group II calls for 4 different steps (accepting, matching, informing and allowing). Secondly, the scope of the claimed language has its own interpretation. For example, it is not necessarily that accepting step is essentially must have the step of accessing and recording. Similarly, it is not necessarily that the matching step of claim 27 is necessarily the same concept of determining step of claim 1 because claim 1 call for the step of determining the accessing information while the claim 27 calls for matching the accept information. And, the scope of accessing information is not necessarily the same scope of the accept information.

c) On page 3 of the applicant remark, the applicant argued that claim 52 of Group IV requires remembering abstract (similar to recording of claim 1), searching (similar to accessing of claim 1) and notifying information seeker about matches (similar to determining of claim 1). **In reply**, Examiner respectfully disagrees because first of all Group I calls for three steps (recording, accessing and determining) while Group IV calls for only two different steps (searching and notifying). Secondly, the scope of the claimed language has its own interpretation. For example, it is not necessarily that remembering abstract of claim 52 is essentially must have the step of recording. Similarly, it is not necessarily that the searching step of claim 27 is necessarily the

same concept of accessing of claim 1. Moreover, it is not necessarily that the notifying of claim 52 is necessarily the same concept of determining step of claim 1.

Thus, the applicant's arguments are not found persuasive as mentioned above, and therefore the requirement is still deemed proper and it is made FINAL.

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Claims 27-43, 52-60 and ~~75~~⁷⁷-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **with** traverse in Paper No. 8, filed 10/29/03.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-26, 44-51, 61-70 and 75-78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Frauenhofer et al. [U.S. Patent No. 6,236,991] in view of Herz et al. [U.S. Patent No. 5,754,939].

2. Frauenhofer et al. disclosed (e.g., see Figs. 1-2) the invention substantially as claimed. Taking claims 1, 75 and 78 as exemplary claims, the reference disclosed a method for delivering information to a requesting user (e.g., see the abstract, col. 2, lines 9-10), the method comprising the steps of:

a) recording a request from a user pertaining to information content desired by the said user (e.g., "collecting and categorizing customized user profiles" see the abstract, "creating a user profile", see col. 2 (lines 25 and 66-67), col. 3 (line 5), col. 5 (line 8), col. 6 (line 38));

b) accessing the recorded request by any information provider (sources 11, content providers 12, "actively collect and categorize ... content for delivery ...", see the abstract, col. 2, lines 1-27); and

c) determining by said accessing information provider whether or not the information said accessing provider has control of matches the information content requested by the user (matching and delivering categorized information to customized user profiles, see the abstract, col. 2, col. 3, line 15, and col. 6, lines 55-59).

3. While Frauenhofer et al. disclosed the invention as mentioned above, Frauenhofer et al. did not explicitly mention the exact term or phrase as claimed language, Frauenhofer, however, clearly disclosed the gist of the invention. For example, Frauenhofer clearly disclosed a method of delivering information to a requesting user having steps a) to c) as mentioned above with different use of terms and languages. Thus, it would have been obvious to one of an ordinary skill in the art at the time the invention was made to recognize such different terms and languages would have obviously a matter of using the terms and languages.

4. As to claim 2, Frauenhofer et al. disclosed the feature of using the Internet for accessing information (e.g., see Figs. 1-2). Moreover, this feature was also taught by Hertz et al. (e.g., see Figs. 1-2, col. 79, lines 5-6).

5. Since both of these two references are directed toward to the method and a system for delivering information to a requesting user based on a user profile or a user interest, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Herz's system into Frauenhofer's

system in order to enhance Frauenhofer's system with additional features of Herz's for delivering information to a requesting user based on a user profile.

6. As to claim 3, Frauenhofer et al. disclosed the feature of connection from the provider (content provider 12) directly to the user (16) (see Fig. 1). Moreover, this feature was also taught by Hertz et al. (e.g., see step 1600 of Fig. 16)

7. As to claim 4, Frauenhofer et al. disclosed the feature of user information to control the accessing of such request by third party (different restriction for user access, col. 5, lines 15-16). Moreover, this feature was also taught by Hertz et al. (e.g., see last 3 lines of the abstract).

8. As to claim 5, Frauenhofer et al. disclosed at least partial control of the determining step delivering the information desired by the user (provision of the matched documents for the end user review, col. 5 (lines 11-12)).

8. As to claim 6, Frauenhofer et al. disclosed the feature of interacting between the accessing provider and the user as to the nature of the information to be delivered (e.g., see col. 5, line 14).

9. As to claims 7-19, while Herz et al. disclosed the user's profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, Herz et al. however, did not explicitly detail about the time of delivery, types of media for delivery, content of delivery, location of delivery,

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location of the user, location of a provider, etc. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such detail features would have been a matter of programming choices and therefore these features are not patentably distinguishable features.

10. As to claims 76 and 77, the use of e-mail message and wireless communication as a means for communicate among devices or users in a communication network are well known features in the art at the time the invention was made.

11. Claims 20-26, 44-51 and 61-70 are similar in scope as of claims 1-19 and 75-78, and therefore claims 20-26, 44-51 and 61-70 are rejected for the same reasons set forth above for claims 1-19 and 75-78.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krishna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

KI

January 9, 2004



KRISNA LIM
PRIMARY EXAMINER